



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARKS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/735,931	12/14/2000	Ryoh Itoh	K-1948	5805

7590 05/01/2003

KANESAKA AND TAKEUCHI
Suite 2
1423 Powhatan Street
Alexandria, VA 22314

EXAMINER

TALBOT, BRIAN K

ART UNIT	PAPER NUMBER
----------	--------------

1762

DATE MAILED: 05/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/735,931

Applicant(s)

ITOH, RYOH

Examiner

Brian K Talbot

Art Unit

1762

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 February 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

Art Unit: 1762

1. The amendment filed 2/13/03 has been entered. Claims 9-11 have been added. Claims 1-11 remain in the application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. In light of the amendment filed 2/13/03, the 35 USC 112 second paragraph rejections have been withdrawn.

Claim Rejections - 35 USC § 103

4. Claims 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's admitted state of the art (pgs. 1-4) in combination wither either Kawagishi et al. (4,940,608) or Grosclaude (5,388,754) or Kanoh et al. (5,989,787).

Applicant's admitted state of the art (pgs. 1-4) teaches selective coating of substrates including the steps of roughening, masking, catalyst, plating and removing the mask and catalyst. The sequence of steps can vary to achieve the desired coating pattern.

Applicant's admitted state of the art (pgs. 1-4) fails to teach a masking coating which is water soluble or hydrolyzable.

Kawagishi et al. (4,940,608) or Grosclaude (5,388,754) or Kanoh et al. (5,989,787) all teach masking coating which are hydrolyzable and can be removed by water or a solution including water.

Art Unit: 1762

Therefore, it would have been obvious for one skilled in the art at the time the invention was made to have modified Applicant's admitted state of the art (pgs. 1-4) process by substituting a water soluble or hydrolysable masking coating as evidenced by Kawagishi et al. (4,940,608) or Grosclaude (5,388,754) or Kanoh et al. (5,989,787) because of the advantages associated with their use, i.e. ease of removal, less contamination, less potential damage to substrate, etc.

Response to Amendment

5. Applicant's arguments filed 2/13/03 have been fully considered but they are not persuasive.

Applicant argued that the secondary prior art fails to teach injection molding the coating material.

While the Examiner acknowledges this fact, the primary reference teaches injection molding (further acknowledge on pg. 10, last full paragraph of response filed 2/13/03). The secondary references are cited as teaching water soluble or hydrolysable coating and not for the techniques utilized to deposit them.

Applicant argued that the prior art's coating material is not water soluble or hydrolyzable.

Art Unit: 1762

The Examiner disagrees. The references teach removing the coating material with a solution containing water.

6. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the mailing date of this final action.

7. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian K Talbot whose telephone number is (703) 305-3775. The examiner can normally be reached on Monday-Friday 6AM-3PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shrive P Beck can be reached on (703) 308-2333. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9310 for regular communications and (703) 872-9311 for After Final communications.

Application/Control Number: 09/735,931

Page 5

Art Unit: 1762

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3775.



Brian K Talbot
Primary Examiner
Art Unit 1762

BKT
April 28, 2003